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IN THE

Supreme Court of the United States

OCTOBER TERM, 1960.

No. 522

VACO PRODUCTS CO.,

Petitioner,

vs.

AMP INCORPORATED,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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Question Presented

Were the differences between the novel bolt cutter described and claimed in the Wenger U. S. patent No. 2,560,318 and the rod cutter disclosed in the 1855 Grover patent No. 13,570 such that the patented subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains?

Statute Involved

In addition to 35 U. S. C. § 103, which is set forth at page 3 of the Petition for Writ of Certiorari, the following statute is involved:

> 35 U. S. C. § 282. **Presumption of validity; defenses**—A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it. * * * (July 19, 1952, c. 950, § 1, 66 Stat. 812).

Statement of the Case

The "Statement of the Case" presented at pages 3-6 of the Petition for Writ of Certiorari omits mention of the following significant facts, all of which are quoted from the Opinion of the Court of Appeals as set forth at pages 13 to 19 of the Petition:

The bolt cutter covered by the claims of the Wenger patent in suit ". . . provided the first device in history capable of cutting bolts and screws without damaging their threads." [Petition, p. 19]

> "Bolts and screws have been in common use at least since the so-called Industrial Revolution, about 1760. Many times a bolt or screw of a particular length is needed and not available. Various procedures and devices have been employed in the past for shortening available bolts and screws to a desired length. One method was cutting with a hacksaw. When smaller screws were used, side-cutting pliers could be used. Special tools of considerable size were utilized for cutting larger size bolts and screws, many of them having guillotine-type cutting jaws.

"The evidence in the record before us discloses that these prior methods and apparatus, when used, damage the threads of the bolts and screws being cut. When a hacksaw was used, the threads adjacent to the cut were inevitably damaged, and burrs were usually formed. In using a commercial bolt-cutter and side-cutting pliers, the ends of the threads were bent laterally, and the end of the bolt or screw was pinched to a 'chisel point' described in the testimony as an overall shape comparable to that of the end of a pillow. In the blunt-edged shearing device of the type shown in the Grover patent No. 13570, the edges of the threads were flattened on one side.

"After the threads were damaged by the cutting device, the bolts and screws could not be used until the threads had been 'dressed' or restored to their original shape. This was often done by filing them with a sharp-cornered file. This was a time-consuming job, and unless done with care, the threads might easily be further damaged." [Petition, p. 14]

In the use of the patented device, on the other hand, since the screw is supported in a threaded hole, which

"... conforms accurately to the intricate shape of the threads of the shank of the screw, it distributes the shearing force uniformly throughout the entire surface of the screw and thus prevents damage. When the screw is removed from the tool, it is ready for immediate use without the necessity of 'dressing' the threads." [Petition, p. 15]

"The device met with commercial success." [Petition, p. 15] "The United States Navy specified the patented bolt-cutting elements as standard equipment in certain types of hand tools." [Petition, p. 16]

> "Defendant does not deny that it incorporated the bolt and screw-cutting elements after having seen plaintiff's tools on the market." [Petition, p. 16]

> The Grover patent No. 13570 was "the sole patent relied on by the District Court . . ." This patent was "cited by the Patent Office and given full consideration during the prosecution of the application for the patent in suit." [Petition, p. 16]

In Petitioner's "Statement of the Case" there also are a number of significant *mis*statements:

1. On page 4 it is stated that

> "Since about 1935, it has been the common, usual practice of mechanics, when filing or cutting a screw, to retain it in a nut or similar threaded aperture which conforms to and supports the thread of the screw, to prevent the working force from flattening the thin edges of the screw against a flat surface."

There is no evidence supporting that statement. Petitioner cites page 39a of the Appendix to Respondent's Brief before the Court of Appeals. However, a reading of the cited portion of the record makes it clear that the testimony did not refer to the use of a nut to support the thread of the screw and prevent the working force from flattening the edges of the screw thread, as Petitioner states. Instead, it referred to the practice of "putting on the nut, then biting off the screw, then unscrewing the nut to dress it." The nut did not protect the edges of the screw thread from damage, but merely served as a crude die for reforming the threads after they had been damaged. This was the

practice which the Court of Appeals referred to in its Opinion as being subject to serious disadvantages:

> "Usually it took considerable force to remove the nut from the screw after the threads had been distorted. Hence, it often was necessary to hold the nut by a vise or other comparable means. Added difficulty was caused by the fact that the threads of the screw were usually of a harder material than the threads of the nut." [Petition, p. 14]

The last sentence refers to the fact that as the nut was unthreaded from the screw, the harder threads of the screw tended to enlarge and distort the threads of the nut, rather than being reformed by the threads of the nut. Thus, the threads of the screw were not restored to their original size and shape [Pl. App. 56a], and the screw could be used again only with the same nut whose threads had thus been enlarged.

2. On page 4, petitioner states

> "All that was necessary, therefore, to prevent Grover from flattening screw threads was to conform his screw-receiving hole to the shape of the screws."

As the Court of Appeals pointed out, this statement is incorrect:

> "It is not accurate to say that the only change needed to convert the Grover tool into a tool of the type covered by the patent in suit, was the threading of one of the holes of the Grover tool. One hole would have to be threaded in a manner so that the threaded shank of the screw or bolt to be cut could be threaded into it. However, the other matching hole would have to be enlarged to permit the projecting portion of the screw to be received freely by it." [Petition, p. 17]

Moreover, as the Court of Appeals further stated, these changes would not permit the tool to cut screws of the same small size which could have been cut in the tool before:

> "These changes would adapt the tool only for the cutting of screws of a larger size than could have been cut with damage to the threads by the Grover tool before the changes were made." [Petition, p. 17]

3. At page 5, the Petition states that the effect of the Court of Appeals' decision was ". . . to reinstate, after 79 years, a patent monopoly upon the entire combination comprising the [Grover] tool, of which the hole is but one part." The patent in suit has not reinstated the monopoly of the Grover patent. The claims of the patent in suit cover a new combination which is obviously different from that disclosed in the Grover patent. As the Court of Appeals stated in its Opinion,

> "The patent in suit does not claim threaded holes are novel *per se*. Instead, it claims the threaded hole as one of the elements in a novel combination designed to accomplish a result entirely different from the usual purpose of threaded holes, and a result which had not been accomplished by any device theretofore known." [Petition, p. 17]

4. On page 5 of the Petition, it is stated that "The Court of Appeals concluded that the District Court had not applied a sufficiently lenient standard of patentability . . ." This is a manifestly incorrect statement of the Court of Appeals' decision. The Court of Appeals reversed because the District Court had applied an *erroneous* test of invention based upon the apparent

simplicity of the invention when viewed in retrospect. As the Court of Appeals stated in its Opinion:

> "The District Court apparently felt that the invention was too simple to reach the level of inventiveness required for patentability . . . Courts have rejected as a test of invention the apparent simplicity of an invention when viewed in retrospect." [Petition, p. 18]

5. On pages 5 and 6, the Petition states that the Opinion of the Court of Appeals ". . . ignores the *A & P* case" and rejects "the standard consistently imposed by this Court." That is entirely wrong. The *A & P* case [340 U. S. 147 (1950)] was heavily relied on by Defendant-Petitioner in its Brief before the Court of Appeals [pp. 9, 10, 29, 31, 32] and was fully considered by that Court. However, the Court was convinced that the invention covered by the patent in suit met the standard of patentability established by the Supreme Court in that and other cases.

Argument

The present case presents no federal question of substance. Here, as in every patent case, we begin with the proposition that the patent is presumed to be valid [35 U. S. C. § 282]. The only defense which Petitioner raises is that defined by 35 U. S. C. § 103, under which defendant has the burden of showing that:

> ". . . the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which that subject matter pertains."

The evidence adduced at the trial and discussed by the Court of Appeals in its Opinion shows that during the two centuries in which bolts and screws have been in common use, it had been a frequent occurrence that a bolt or screw of a particular length was needed but was not available. Even amateur mechanics and do-it-yourself repairmen are frequently confronted with this problem.

Over the years, many procedures and devices were devised for shortening bolts and screws to the desired length. However, all of these prior methods had this common deficiency: they distorted the threads so that the bolt or screw could not be used until the threads had been "dressed" or restored to something approximating their original size and shape. This job of dressing the threads not only consumed appreciable time, but frequently resulted in further damaging the threads so that the bolt or screw could not be used. But for two centuries, the aggregate ingenuity of mankind had been unable to provide anything better.

Petitioner contends that it would have been "obvious" to thread one of the holes in a tool of the type shown in the 1855 Grover patent and enlarge the mating hole in order to construct a device of the type covered by the patent in suit. But the fact remains that in the 96 years after the Grover patent issued, during which countless thousands of mechanics used a tool of the type shown in the Grover patent for cutting bolts and screws, no one *did* conceive this idea. In the face of these undisputed facts, it seems impossible to conclude that the patented invention would have been "obvious . . . to a person having ordinary skill in the art."

The Petition for Writ of Certiorari does not cite any evidence, and indeed the record contains none, establishing the obviousness of the patented invention. Quite the contrary, the evidence strongly tends to establish its patentable ingenuity.

Petitioner's entire case is based upon the argument that the patented device is mechanically simple. In answering that argument, we do not believe we can improve upon the statement of the Court of Appeals in its Opinion:

> "The handtool incorporating the invention of the patent in suit is admittedly of uncomplicated construction. But the fact that the solution was simple does not mean the solution was obvious. Many thousands of mechanics over a period of nearly one hundred years had cut bolts and screws in the old cumbersome thread-damaging ways, yet did not come up with the solution shown by the patent in suit.
>
> "Courts have rejected as a test of invention the apparent simplicity of an invention when viewed in retrospect. *Diamond Rubber Company* v. *Consolidated Rubber Tire Co.*, 220 U. S. 428; *Goodyear Tire and Rubber Co.* v. *Ray-O-Vac Co.*, 321 U. S. 275, 279. In *Charles Peckat Mfg. Co.* v. *Jacobs*, 7 Cir., 178 F. 2d 794, 801, this Court said: 'That Peckat's device now seems comparatively simple, of course, is no criterion of his invention. "The apparent simplicity of a new device often leads an inexperienced person to think that it would have occurred to anyone familiar with the subject; but the decisive answer is that with dozens and perhaps hundreds of others laboring in the same field, it had never occurred to anyone before. The practiced eye of an ordinary mechanic may be sufficiently trusted to see what ought to be apparent to everyone." (Citing cases)'

> "Pertinent is the comment of this Court in *Pyle National Co. etc.* v. *Lewin*, 7 Cir., 92 F. 2d 628, 630: 'It is also insisted that the idea involved in appellee's device is so simple and obvious it does not constitute invention. True, it now has that appearance. The fact, however, that this improvement was long overlooked, using devices far less satisfactory, cannot be ignored.' " [Petition, p. 18]

In the *Diamond Rubber Co.* case cited by the Court of Appeals, the U. S. Supreme Court laid the "hindsight" test to rest with an even more eloquent epitaph:

> "Many things, and the patent law abounds in illustrations, seem obvious after they have been done, and 'in the light of the accomplished result,' it is often a matter of wonder how they so long 'eluded the search of the discoverer and set at defiance the speculations of inventive genius.' *Pearl v. Ocean Mills*, 2 Bann. & Ard. 469, Fed. Cas. No. 10,876, 11 Off. Gaz. 2. Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skillful attention. But the law has other tests of the invention than subtle conjectures of what might have been seen and yet was not."

Petitioner contends the Court of Appeals rejected the decision of this Court in the *A & P* case [340 U. S. 147 (1950)] *sub silentio*. However, considering the repetitious and emphatic way in which Petitioner cited the *A & P* case before the Court of Appeals, it is obvious that the Court of Appeals was fully aware of the rule of this Court as laid down in the *A & P* case, and

merely found that rule inapplicable to the facts of the present case.

On page 8 of the Petition, it is argued that the commercial success which Respondent's tools have enjoyed is attributable not to the patented bolt-cutting feature but to other features of the tool. This argument is in direct conflict with the uncontradicted testimony. For example, Mr. Frank P. Mertes, who is a buyer for Sears Roebuck, testified that his company never purchased Respondent's tools until the bolt-cutting feature was added, and that it was the bolt-cutting feature which finally convinced Sears Roebuck to buy these tools [Pl. App. 46a].

On page 9 of the Petition, it is argued that

> "Not even in the Wonderland of Oz has there ever been an industry devoted to manufacturing excessively long screws so that 'many thousands of mechanics' could be occupied in the symbiotic industry of cutting them down to size."

That argument indicates the absurd extremes to which Petitioner has been extended in its attempts to belittle the invention. It is obvious that manufacturers of bolts and screws cannot anticipate all of the uses to which they will be put and, even if they could, they could not, as a practical matter, provide screws of all diameters in every length which could conceivably be desired. And, of course, no user could possibly stock all of these lengths. Instead, as the evidence shows, bolts and screws are manufactured in certain standard lengths. There arise many occasions, for example where the end of the bolt or screw which projects beyond the nut is exposed, where it might detract from

the appearance of a finished assembly or interfere with adjacent parts or create a safety hazard, when it is desirable to cut the bolt or screw so that its end is flush against the outer face of the nut.

Petitioner has strived mightily to make the patented invention appear trivial and useless. However, as the Court of Appeals pointed out in its Opinion [Petition, p. 16], "Defendant does not deny that it incorporated the bolt and screw-cutting elements after having seen plaintiff's tools on the market." The patented invention was not too trivial and useless for Petitioner to copy it and incorporate it into its existing hand tools to promote their sale. Petitioner's present depreciation of the invention is clearly something less than sincere.

Finally, on pages 9 and 10 of the Petition, it is argued that the obviousness of the patented invention is shown by the fact that when the mechanic Stevens later had a similar idea and submitted it to Popular Science Magazine, the magazine devoted only part of a page to it, rather than making it a lead article with a cover illustration. Although it seems unnecessary to answer this argument, which seems to have emanated from the "Wonderland of Oz" to which Petitioner has referred, a complete answer lies in the fact that the Stevens article was not published until sometime after Respondent's tools embodying the patented invention had gone into widespread commercial sale [Finding No. 7 of the District Court, p. 5a of Appendix to Plaintiff-Appellant's Brief before the Court of Appeals; and Opinion of the Court of Appeals, Petition, p. 15]. Under these circumstances, it is quite a tribute

to the invention that Popular Science Magazine still found it worthy of publication.

Incidentally, a quick reading of the last paragraph on page 9 of the Petition might give the impression that Stevens independently conceived the patented invention *before* the patentee Wenger did. This is directly contrary to the evidence and Finding 5 of the District Court [Pl. App. 5a]. Although Petitioner took no cross-appeal from that Finding, its Appeal Brief [pp. 25, 26] did refer to the alleged prior use by Stevens, which prompted the Court of Appeals in its Opinion to observe that this claim of prior use had not been sustained by the District Court [Petition, p. 16].

It thus appears that what we have here is a case in which the patented device was admittedly new, and constituted the first solution of a problem which had persisted for two centuries, which has enjoyed substantial commercial success, and which defendant has brazenly copied; a case in which the only prior art upon which Petitioner relies is a 96-year-old patent which had been cited and considered by the Patent Office prior to its allowance of the patent in suit. There not only seems to be ample support for the decision of the Court of Appeals, but any other decision would appear clearly erroneous.

This is not a case involving an important issue of constitutional law or even a difficult question of statutory interpretation on which the lower Federal Courts require guidance. Instead, it is just another case in which a disgruntled losing party wants another hearing before a different tribunal. It does not warrant the attention of this Court.

Conclusion

The Petition for Writ of Certiorari should be denied.

Respectfully submitted,

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